

§ 41.31

For the convenience of the user, the added text is set forth as follows:

§ 41.30 Definitions.

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Record means the official content of the file of an application or reexamination proceeding on appeal.

§ 41.31 Appeal to Board.

(a) *Who may appeal and how to file an appeal.* (1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(b) The signature requirement of § 1.33 of this title does not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

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EFFECTIVE DATE NOTE: At 73 FR 32973, June 10, 2008, § 41.31 was revised, effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this action was delayed indefinitely.

For the convenience of the user, the revised text is set forth as follows:

§ 41.31 Appeal to Board.

(a) *Notice of appeal.* An appeal is taken to the Board by filing a notice of appeal.

(b) *Fee.* The notice of appeal shall be accompanied by the fee required by § 41.20(b)(1).

(c) *Time for filing notice of appeal.* A notice of appeal must be filed within the time period provided under § 1.134 of this title.

(d) *Extensions of time to file notice of appeal.* The time for filing a notice of appeal is extendable under the provisions of § 1.136(a) of this title for applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

(e) *Non-appealable issues.* A non-appealable issue is an issue not subject to an appeal under 35 U.S.C. 134. An applicant or patent owner dissatisfied with a decision of an examiner on a non-appealable issue shall timely seek review by petition before jurisdiction over an appeal is transferred to the Board (*see* § 41.35). Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue may constitute a waiver to having that issue considered in the application or reexamination on appeal.

§ 41.33 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief

pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

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For the convenience of the user, the revised text is set forth as follows:

§ 41.33 Amendments and evidence after appeal.

(a) *Amendment after notice of appeal and prior to appeal brief.* An amendment filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted as provided in § 1.116 of this title.

(b) *Amendment with or after appeal brief.* An amendment filed on or after the date an appeal brief is filed may be admitted:

(1) *To cancel claims.* To cancel claims provided cancellation of claims does not affect the scope of any other pending claim in the application or reexamination proceeding on appeal, or

(2) *To convert dependent claim to independent claim.* To rewrite dependent claims into independent form.

(c) *Other amendments.* No other amendments filed after the date an appeal brief is filed will be admitted, except as permitted by §§ 41.50(b)(1), 41.50(d)(1), or 41.50(e) of this subpart.

(d) *Evidence after notice of appeal and prior to appeal brief.* Evidence filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted if:

(1) The examiner determines that the evidence overcomes at least one rejection under appeal and does not necessitate any new ground of rejection, and

(2) appellant shows good cause why the evidence was not earlier presented.

(e) *Other evidence.* All other evidence filed after the date an appeal brief is filed will not be admitted, except as permitted by §§ 41.50(b)(1) or 41.50(d)(1) of this subpart.

§ 41.35 Jurisdiction over appeal.

(a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

(b) If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take other appropriate action to permit completion of the file.

(c) Prior to the entry of a decision on the appeal by the Board, the Director may sua sponte order the proceeding remanded to the examiner.

EFFECTIVE DATE NOTE: At 73 FR 32973, June 10, 2008, § 41.35 was revised, effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this action was delayed indefinitely.

For the convenience of the user, the revised text is set forth as follows:

§ 41.35 Jurisdiction over appeal.

(a) *Beginning of jurisdiction.* The jurisdiction of the Board begins when a docket notice is mailed by the Board.

(b) *End of jurisdiction.* The jurisdiction of the Board ends when:

(1) The Board mails a remand order (*see* § 41.50(b) or § 41.50(d)(1) of this subpart),

(2) The Board mails a final decision (*see* § 41.2 of this part) and judicial review is sought or the time for seeking judicial review has expired,

(3) An express abandonment is filed which complies with § 1.138 of this title, or

(4) A request for continued examination is filed which complies with § 1.114 of this title.

(c) *Remand ordered by the Director.* Prior to entry of a decision on the appeal by the Board (*see* § 41.50), the Director may sua sponte order an application or reexamination proceeding on appeal to be remanded to the examiner.

§ 41.37 Appeal brief.

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.